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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,679	06/22/2000	Robert J. Brockway	TER003RA	7502

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11/05/2002

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EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/599,679

Applicant(s)
R. J. Brockway

Examiner
Russell D. Stormer

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3617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 Oct 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25, 26, and 29-31 is/are pending in the application.
- 4a) Of the above, claim(s) 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23, 25, and 29 is/are allowed.
- 6) ☒ Claim(s) 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 Jun 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Reissue Application

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, **must** be received before this reissue application can be allowed. See 37 CFR 1.178.

Failure to surrender the original patent as required **will** result in a delay in the allowance of this reissue application

Election/Restriction

2. Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 26 sets forth the limitation of “mounting” a plurality of compaction cleats on the rim. This limitation is not found in the apparatus claims and infers that the cleats are separate members attached to the rim. Claim 21, for instance, makes no distinction as to whether the cleats are integral with the rim or mounted thereto. The mounting of the cleats to the rim is a method step and not part of the originally filed claims.

The method of making the compactor wheel as set forth in claim 26 comprises a method which was not set forth in the originally filed claims 1-23.

Method claims define a different statutory class of invention from apparatus claims.

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A search for the method of constructing a wheel would require an additional search in at least class 29, which was not required in examination of the originally filed claims, and therefore would present an extreme burden on the Examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 remains withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Reissue Declaration

3. The supplemental reissue declaration filed October 15, 2002 is acceptable.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the outermost row of cleats “disposed immediately adjacent” the periphery of the drum as set forth in claim 30 must be shown or the feature canceled from the claim. **No new matter should be entered.**

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

5. The specification is objected to under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for the claimed subject matter.

There is no description and therefore no support for the limitation of the outermost rows of teeth being disposed “immediately adjacent” the outer periphery of the cylindrical drum as set forth in lines 8 and 9 of new claim 30.

It should be noted that the use of the term “teeth” in the new claims when the term “cleats” is used in the specification is not objected to and the lack of antecedent basis objection set forth above concerns the location of the teeth on the drum as claimed and not the terminology used.

See MPEP § 608.01(o).

Claim Rejections - 35 USC § 112

6. Claims 30 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the specification is silent on the definition of the term “immediately adjacent” as used in claim 30, one of ordinary skill in the art would not be enabled to make and/or use the claimed invention because it is not clear where the outermost row of teeth or cleats should be disposed.

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7. Claims 30 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure as originally filed does not include any description of the outermost row of cleats or teeth being disposed "immediately adjacent" the outer periphery of the drum of the wheel as now claimed in newly presented claim 30. THIS IS A NEW MATTER REJECTION.

8. Claims 30 and 31 filed with the amendment of October 15, 2002 have been copied from United States Patent No. 5,687,799. These claims are not patentable to Applicant because Applicant cannot show support for the claims in the specification as originally filed as explained in paragraph 5 above.

Interference

9. Claims 30 and 31 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,687,799 was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

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Allowable Subject Matter

10. Claims 1-23, 25, and 29 are allowable over the prior art of record.

Response to Arguments

11. Applicant's arguments filed October 15, 2002 have been fully considered but they are not persuasive.

With respect to the restriction, Applicant's argument that the restriction requirement is improper because the Examiner has not explained why the examination of the invention of claim 26 would be a burden is not a valid argument. Further, Applicant's allegation is not true. See paragraph 2 of the office action dated June 5, 2002.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-1113.

rds

October 30, 2002


RUSSELL D. STORMER 10/30/02
PRIMARY EXAMINER